

AMENDMENTS TO THE DRAWINGS:

The attached Replacement Sheet replaces the original sheet including Fig. 1. In Figure 1, previously omitted elements 145 and 199 have been added.

REMARKS

The Application has been reviewed in light of the Office Action dated April 5, 2006. Claims 1-7 and 9 are presented for examination; Claims 1, 3, 4 and 7 have been amended to better define what Applicants regard as the invention. Claim 8 has been canceled, without prejudice or disclaimer of subject matter. Favorable reconsideration is respectfully requested.

Rejections under 35 U.S.C. 112

Claims 3, 6, and 9 stand rejected under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. In particular, the Office Action states that it was not clear how the applicant can annotate data sets for storage onto a financial transaction instrument. The rejections under 35 U.S.C. § 112, first paragraph, are respectfully traversed for the following reasons.

Claim 3 recites that data sets are annotated for storage onto a financial transaction instrument. The annotation of data for storage onto a financial transaction instrument is described, for example, at paragraph 26 of the specification:

[0026] As stated above, in various embodiments of the present invention, the data can be stored without regard to common format. However, in one exemplary embodiment of the present invention, the data set (e.g., BLOB) may be annotated in a standard manner when provided for manipulating the data onto the financial transaction instrument. The annotation may comprise a short header, trailer, or other appropriate indicator related to each data set that is configured to convey information useful in managing the various data sets. For example, the annotation may be called a "condition header," "header," "trailer," or "status," herein, and may comprise an indication of the status of the data set or may include an identifier correlated to a specific

issuer or owner of the data. In one example, the first three bytes of each data set BLOB may be configured or configurable to indicate the status of that particular data set; e.g., LOADED, INITIALIZED, READY, BLOCKED, REMOVABLE, or DELETED. Subsequent bytes of data may be used to indicate for example, the identity of the issuer, user, transaction/membership account identifier or the like. Each of these condition annotations are further discussed herein.

It is clear from this cited portion of the specification that annotation of the data may be accomplished, for example, by adding a header or trailer to the data. The specific details of how to add a header or trailer to data are well-known in the art. Applicants therefore submit that one of ordinary skill in the art would readily understand how to annotate the data for storage on a financial transaction instrument. Nevertheless, Claim 3 has been amended to recite that the plurality of data sets are annotated for storage onto a financial transaction instrument with at least one of a header or a trailer. By dint of this amendment, it is now even more apparent that the specification would enable one of ordinary skill in the art to make and use the claimed invention.

Claims 2, 3, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 112, second paragraph, allegedly as being indefinite. The rejections under 35 U.S.C. § 112, second paragraph, are respectfully traversed for the following reasons.

The relevant legal question under 35 U.S.C. § 112, second paragraph is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” M.P.E.P. § 2173.02. “Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the

time the invention was made.” *Id.* “If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. § 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is ‘vague and indefinite’ should be included in the Office action.” *Id.* (emphasis added).

Regarding Claims 2, 5, and 8 the Office Action asks, “what does the applicant mean by a fixed memory offset?” (Office Action at paragraph 3). However, in the absence of any analysis as to why the term “fixed” was deemed indefinite, Applicants respectfully submit that proper ground for a rejection under 35 U.S.C. § 112, second paragraph, has not been established.

Under a proper analysis of Claims 2, 5, and 8, taking into account the content of the disclosure and the interpretation that would be given by one of ordinary level of skill in the art, it is apparent that these claims are not indefinite. For example, paragraph 25 of the specification discusses the storage of data as sets of ungrouped data elements formatted as a block of binary, using a fixed memory offset, which facilitates the sharing of data among different data set owners:

[0025] In one exemplary embodiment, the ability to store a wide variety of information in different formats is facilitated by storing the information as a Block of Binary (BLOB). Thus, any binary information can be stored in a storage space associated with a data set. As discussed above, the binary information may be stored on the financial transaction instrument or external to but affiliated with the financial transaction instrument. The BLOB method may store data sets as ungrouped data elements formatted as a block of binary via a fixed memory offset using either fixed storage allocation, circular queue techniques, or best practices with respect to memory management (e.g., paged memory, least recently used, etc.). By using BLOB methods, the ability to store various data sets that have different formats facilitates the storage of data associated with the financial transaction instrument by multiple and unrelated owners of the data sets.

For example, a first data set which may be stored may be provided by a first issuer, a second data set which may be stored may be provided by an unrelated second issuer, and yet a third data set which may be stored, may be provided by an third issuer unrelated to the first and second issuer. Each of these three exemplary data sets may contain different information that is stored using different data storage formats and/or techniques. Further, each data set may contain subsets of data which also may be distinct from other subsets.

It is respectfully submitted that one of ordinary skill in the art would readily be able to ascertain the meaning of the term “fixed” in the context of this cited portion of the disclosure. Moreover, the phrase “fixed memory offset” is a term of art that would be understood by those of ordinary skill in the art.

The Office Action seems to suggest that the term “fixed” must be explicitly defined in order for the claims to be definite, however there is no such requirement in the patent laws or USPTO rules. To the contrary, “a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible.” M.P.E.P. § 2173.02 (citing *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004)), and it is respectfully submitted that the meaning of “fixed” is easily discernible.

Regarding Claims 3, 6, and 9, the Office Action asks: “What does the applicant mean by a plurality of data sets are annotated for storage onto a financial transaction instrument? What does the applicant define as a financial transaction instrument?” (Office Action at paragraph 4). Again, as discussed above, there is no legal requirement to explicitly define the terms used in the claims if their meaning can be discerned. The term “financial transaction instrument” is known to those of ordinary skill in the art and is easily discernible, particularly in view of the disclosure and the teachings

of the prior art. For example, paragraph 50 of U.S. Patent Application No. 10/611,037 (to which the present application claims priority) discusses that financial transactions can be facilitated by the use of an account number stored on various types of cards, all of which are examples of financial transaction instruments:

Access to the benefits of the system, and financial transfers or payments made in connection with transactions facilitated by the system, may themselves be facilitated through the use of an account number or other information which identifies a user or a financial or other account of a user. An “account number,” as used herein, includes any device, code, or other identifier and/or indicia suitably configured to allow a consumer or agent to access, interact with, or communicate with the system such as, for example, one or more of an authorization/access code, a personal identification number (PIN), and Internet code, other identification code, and/or the like which may be optionally located on or associated with a rewards or incentives card, charge card, credit card, debit card, prepaid card, telephone card, smart card, magnetic stripe card, bar code card, or an associated account. Such an account number may be distributed and stored in any form of plastic, electronic, magnetic, and/or optical device capable of transmitting or downloading data from itself to a second device.

Because the language of Claims 2, 3, 5, 6, and 9 is such that a person of ordinary skill in the art could interpret the metes and bounds of these claims, so as to understand how to avoid infringement,¹ the language used by Applicants is believed to satisfy the statutory requirements of 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of these rejections is respectfully requested.

¹ M.P.E.P. § 2173.02 (citing *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)).

Rejections under 35 U.S.C. 103(a)

Claims 1-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,832,454 (“Jafri”). Claims 7-9 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jafri in view of U.S. Patent No. 6,944,133 (“Wisner”).

It is well settled that, when applying 35 U.S.C. § 103, references must be considered as a whole, and such references “must suggest the desirability and thus the obviousness of making the combination.” M.P.E.P. § 2141. In order for the examiner to establish a *prima facie* case of obviousness, there “must be some suggestion or motivation...to modify the reference or to combine the teachings.” M.P.E.P. § 2142. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01. In addition, the prior art reference or references must “teach or suggest all the claim limitations.” *Id.* Moreover:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line or reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”

M.P.E.P. § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). “While ‘official notice’ may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. 1.113.” M.P.E.P. § 2144.03(A).

Examples of problems with efficiency and connectivity experienced by travel offices are set forth in paragraph 4 of the specification:

[0004] Unfortunately, a direct connection between the travel offices and the GDS typically created a reliance on the GDS, thereby resulting in traveler reservations that may not have been very cost efficient. Additional problems have often arisen due to the complexity and cost related to maintaining and updating hardware and software, especially on those systems where there are multiple GDS networks and desktop standards. In addition, there is often a lack of connectivity between travel offices that utilize different GDS systems or configurations due to the private autonomous nature of GDS networks. The autonomous nature of GDS networks lead to further inefficiencies such as the inability to deliver Internet access to the travel offices through the same system. Internet access is desired, as it would allow for the integration of traveler reservations with low costs inventories such as Internet fares and/or connection with vendor direct inventory.

The present invention responds to these problems by providing for an integrated travel market broker system, which facilitates substantial technological independence from, or limited dependence on, the GDSs. The ability to store various data sets that have different formats enables increased independence from the GDS by facilitating the storage of data by multiple and unrelated owners of the data sets.

Official Notice was taken that it is well known to store files in a plurality of formats and that web portals or gateways are used for exchanging data and connecting networks using different communication protocols, especially electronic data by allowing communities to interchange data stored in remote repositories while allowing databases to use different formats. Applicants respectfully traverse these assertions and request that the Examiner cite a reference in support of this position in accordance with M.P.E.P. § 2144.03. As specifically acknowledged in the Office Action, Jafri does not teach or

suggest a system for facilitating transactions among travel service suppliers and travel service buyers in which the broker database and/or the travel history database stores information in a plurality of data sets in a plurality of formats as recited in Claim 1.

The Office Action states that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the reservation system of Jafri the ability to access and store data in different formats so as to be able to exchange data with multiple business to business protocols, i.e., multiple CRSs or other reservation providers. However, the mere idea that data may be stored and accessed in different formats does not suggest why the travel market broker system disclosed in the present invention would be obvious to one of ordinary skill in the art. The present invention is responsive to specific problems, such as the complexity and cost related to maintaining hardware and software on systems where there are multiple GDS networks and desktop standards. The Office Action acknowledges that Jafri does not teach or suggest this key feature that makes the travel market broker system particularly responsive to the problems experienced in the travel industry. In so doing, the Examiner has explicitly admitted that the prior art reference does not teach or suggest all the claim limitations, the core requirement for establishing obviousness under 35 U.S.C. § 103. It is therefore respectfully submitted that the burden of presenting a “convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of [Jafri]” has not been met.

Furthermore, the art of record, including Jafri, does not suggest the desirability and thus the obviousness of the present invention. As stated, there must be some suggestion or motivation to modify the reference. M.P.E.P. § 2142. Merely stating

that it would be obvious to incorporate into Jafri conclusions over which official notice was taken does not render the resultant combination obvious “*unless the prior art also suggests the desirability of the combination.*” M.P.E.P. § 2143.01 (emphasis added). In the present case, it would be particularly improper to conclude that there is some suggestion or motivation to modify the reference, because Jafri does not address the same problems addressed by the present invention, for example, the problems associated with reliance on multiple, autonomous GDS systems. Accordingly, it is respectfully submitted that a prima facie case of obviousness under 35 U.S.C. § 103 has not been established.

Independent Claims 4 and 7 recite features similar to those discussed above with respect to Claim 1 and therefore are also believed to be patentable over Jafri for the reasons discussed above. In addition, Claim 7 has been amended to recite the features of former dependent Claim 8, and it is respectfully submitted that these features further distinguish the present application from the cited reference.

Claims 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jafri in view of Wisner et al (6,944,133). A review of the other art of record, including Wisner, has failed to reveal anything that, in Applicants’ opinion, would remedy the deficiencies of the art discussed above, as referenced against the independent claims herein. Claims 7-9 are therefore believed patentable over the art of record.

Claims 2, 3, 5, 6, and 9 in this application are dependent from one or another of the independent claims discussed above, and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Provisional Double Patenting Rejection

Claim 7 stands provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1, 8 and 11 of copending Application No. 10/217,666. Claims 1 and 4 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application No. 10/908,544. The provisional double patenting rejections are respectfully traversed for the following reasons.

With respect to Claim 7, the Office Action states that, “[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.”

Claim 7 has been amended to incorporate the features of Claim 8, and Claim 8 has been canceled. Claims 1, 8 and 11 of copending Application 10/217,666 do not teach or suggest the limitation disclosed in Claim 7 as amended, namely wherein the plurality of data sets are stored as ungrouped data elements formatted as a block of binary via a fixed memory offset. As discussed above, there are numerous advantages to these features. For example, the ability to store various data sets that have different formats enables increased independence from the GDS by facilitating the storage of data by multiple and unrelated owners of the data sets. Accordingly, withdrawal of the provisional double patenting rejection of Claim 7 is respectfully requested.

Claims 1 and 4 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application No. 10/908,544. However, Claim 1 of copending Application No. 10/908,544 does not teach or suggest wherein at least one of the broker database and the travel history database stores information in a plurality of data sets in a plurality of formats. This feature has numerous advantages similar to those discussed above, such as increased independence from the GDS. Accordingly, withdrawal of the provisional double patenting rejection of Claims 1 and 4 is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Carl B. Wischhusen", written over a horizontal line.

Carl B. Wischhusen
Attorney for Applicants
Registration No.: 43,279

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_Main 590780_1